

Application No.: 10/533,398  
Amtd. Dated November 16, 2007  
Reply to Office action of August 16, 2007

**REMARKS/ARGUMENTS**

This amendment is filed in response to the Office action that was mailed on August 16, 2007. Claims 1-21 and 39-43 are withdrawn from consideration. By this Amendment, Claims 22, 48 and 49 are amended and Claims 50-60 are new. The amendments and new claims do not add new matter as they are fully supported by the Claims, Specification, and/or Drawings as originally filed or are inherent characteristics thereof. Claims 1-28 and 39-60 are pending in the Application. Applicants respectfully request reconsideration and allowance of all Claims in view of the following remarks.

Claims 22-28 and 44-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,139,555 to Hart et al. (Hart '555). It is indicated in the Office action that Hart '555 discloses the elements of Claim 22 except for the shape of the sliding member. It is also indicated in the Office action that the Examiner considers the modification of the shape of the sliding member to be within the purview of one having ordinary skill in the art, that the device of Hart '555 includes a cylindrical sliding member, and that the claimed rectangular shape for the sliding member, although not stated by Applicant, is simply designed to engage both jaw members. It is further indicated in the Office action that the Examiner notes that other than providing necessary function, for example the sliding member should be shaped so that it engages both jaws and not only one jaw, there is no particular advantage to the design. Applicant respectfully traverses this rejection.

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Each of amended independent Claims 22 and 48 includes a distal portion of each of a first jaw and a second jaw of the pair of opposed jaws being arranged to hold the first and second tissue-engaging members of the staple-clip, respectively, with the jaws being separable from the tissue-engaging members. The distal portions of the first and second jaws are sized and configured to be positioned completely within the elongate shaft while holding the first and second tissue-engaging members of the staple-clip prior to the first and second tissue-engaging members being applied to the body tissue or vessel. Hart '555 fails to disclose this feature.

FIGURE 4 of Hart '555 depicts the jaws (30) positioned distal the shaft (12) with a clip (24) positioned between the jaws and over a compressed vessel (26) prior to the clip being compressed onto the vessel. At the stage depicted in FIG 4 of Hart '555, the profile of the jaws (30) is too large to fit fully within the shaft (12). It is not until the jaws (30) of Hart '555 are substantially fully closed that the jaws have a profile that is substantially small enough to fit completely into the shaft (12), but when the jaws (30) are substantially fully closed, a clip (24) positioned within the jaws is already applied to the vessel (26). Hart '555 does not teach the jaws (30) being able to fit completely within the sheath while holding the first and second tissue-engaging members of the staple clip prior to the tissue-engaging members being applied to the body tissue or vessel. Thus, a prima facie case of obviousness is not established and hence reconsideration and withdrawal of the rejection of Claims 22 and 48 are respectfully requested. Applicants also respectfully submit that Claims 22-28 and 44-47 are

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allowable as depending from allowable Claim 22. Applicants also respectfully request that these rejections be reconsidered and withdrawn as well.

New Claims 50-60 are similar to Claims 22-28 and 44-47, except that they do not include a limitation on the shape of the sliding member. However, as Claim 50 includes the distal portion of each of the first second jaws being arranged to hold the first and second tissue-engaging members of the staple-clip, respectively, with the jaws being separable from the tissue-engaging members, and the distal portions of the first and second jaws being sized and configured to be positioned completely within the elongate shaft while holding the first and second tissue-engaging members of the staple-clip prior to being applied to the body tissue or vessel, Applicant respectfully submits that Claim 50 is allowable over Hart '555. Applicant also respectfully submits that Claims 51-60 are allowable over Hart '555 as depending from allowable Claim 50.

Claim 49 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hart '555 in view of U.S. Patent No. 6,258,105 to Hart et al. (Hart '105). It is indicated in the Office action that hart '555 does not disclose the shape of the jaw members as claimed, but that Hart '105 discloses jaws (30) and a sliding member (58) in which the jaws have a width larger than their height and a height less than the height of the sliding member (FIGS. 1-7). It is also indicated in the Office action that Hart '105 is relied on mostly as a reference to show that the relative size of jaws to sliding members as claimed is not novel. Applicant respectfully traverses this rejection.

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Claim 49 depends from allowable Claim 48. As indicated above, Applicant respectfully submits that Claim 48 is allowable over Hart '555 as being able to fit completely within the sheath while holding the first and second tissue-engaging members of the staple clip prior to the tissue-engaging members being applied to the body tissue or vessel. Applicant respectfully submits that Hart '105 does nothing to correct this deficiency. Thus, a *prima facie* case of obviousness is not established and hence reconsideration and withdrawal of the rejection of Claim 49 is respectfully requested.

In addition to the amendments described above, Claim 49 was amended by replacing the term "~~a~~ first jaw of the pair of opposed jaws holds the second tissue engaging member of the staple-clip" to "the second jaw of the pair of opposed jaws holds the second tissue engaging member of the staple-clip" to correct an inadvertent error in the claim. Applicant respectfully submits that support for this amendment is found in the Specification, Claims and Drawings as originally filed or is an inherent characteristic thereof. Applicant also respectfully submits that this amendment does not affect the scope of Claim 49.

In view of the foregoing remarks, it is respectfully submitted that this application is in condition for allowance. Accordingly, reconsideration of the application and

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allowance of claims 1-28 and 39-60 are respectfully requested. If the Examiner should have any remaining questions or objections, a telephone interview to discuss and resolve these issues is respectfully requested

Sincerely,

APPLIED MEDICAL RESOURCES

BY \_\_\_\_\_



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